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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,369	02/04/2000	Victor H. Shear	07451.0010-01000	8725

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/498,369

Applicant(s)

SHEAR ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 151-155 and 186-195 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 151-155 and 186-195 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 10/27/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent and each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but only the U.S. references referred to therein have been considered.
2. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 10/27/2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 151—155, 186-195 are rejected under 35 U.S.C. 102(e) as being anticipated by Benson et al (5,845,281).

As per Claim 151.

Benson et al ('281) discloses:

creating a secure container, see column 5, line 25;

associating a first rule with the secure container, the first rule at least in part governing use of at least some of the secure container contents, the first rule at least in part specifying potential users or recipients of the secure container contents, the specifying being based at least in part on a first class to which the potential users or recipients have been assigned, see column 5, lines 22-45;

sending the secure container to a first remote party, see column 5, lines 54-59;

the first remote party embedding a first content object in the secure container, see column 5, line 54-59;

receiving a request for a content object from a potential user or recipient, the request specifying a desired class of rights management, see column 5, lines 33-36;

determining that the first content object has rights management information associated with it that belongs to the desired class, see column 5, lines 33-36;

sending the secure container, including the embedded first content object, to the potential user or recipient, see column 5, lines 46-51;

evaluating a digital certificate associated with the potential user or recipient, see column 6, lines 49-54;

determining, based on at least the digital certificate that the potential user or recipient has been assigned to the first class, see column 9, line 60 – column 10, line 5;

based on the determination, and at least in part under control of the first rule, making at least some of the secure container contents available to the potential user or recipient, see column 10, lines 1-5.

As per Claim 152.

Benson et al ('281) further discloses:

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the first remote party associating a second rule with the secure container, the second rule at least in part governing use of at least a portion of the secure container contents, see column 5, lines 46-59;

the step of making at least some of the secure contents available to the potential user occurring at least in part under control of the second rule, see column 10, lines 11-38.

As per Claim 153.

Benson et al ('281) further discloses assigning a user to a first class, the assignment being based at least in part on the potential user's use of the content, see column 10, lines 28-38.

As per Claim 154.

Benson et al ('281) further discloses the assignment of the potential user to the first class is based at least on demographic information, see column 15, lines 6-11.

As per Claim 155.

Benson et al ('281) further discloses following the potential user's access to the secure contents, generating an audit trail describing an aspect of the access and providing the audit trail to a remote site, see column 14, lines 19-35 and column 17, lines 19-20.

As per Claim 186.

Benson et al ('281) further discloses rights management information specifying predefined limitations on redistribution of content, see column 16, lines 25-30.

As per Claim 187.

Benson et al ('281) further discloses rights management information specifying predefined limitations on modification of content, see column 17, lines 1-23.

As per Claim 188.

Benson et al ('281) further discloses the rights management information specifying limitations on the cost of acquiring content, see column 9, line 61 – column 10, line 2.

As per Claim 189.

Benson et al ('281) further discloses the rights management information specifying limitations on the reporting of information regarding usage of content, see column 9, line 61 – column 10, line 2 and column 13, lines 29-50.

As per Claim 190.

Benson et al ('281) further discloses the steps of evaluating that the potential user or recipient has been assigned to the first class, are performed before the step of

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sending the secure container, including the embedding of the first content object, to the potential user or recipient, see column 15, lines 6-11.

As per Claim 191.

Benson et al ('281) discloses:

creating a secure container, see column 5, line 25;

assigning a potential user or recipient to a class, the assignment based at least in part on information regarding the potential user or recipient's previous use of the content, see column 10, lines 15-22;

associating a first rule with the secure container, the first rule at least in part governing use of at least some of the secure container contents, the first rule at least in part specifying potential users or recipients of the secure container contents, the specifying being based at least in part on a first class to which the potential users or recipients have been assigned, see column 5, lines 22-45;

sending the secure container to a first remote party, see column 5, lines 54-59;

the first remote party embedding a content object in the secure container, see column 5, line 54-59;

sending the secure container, including the embedded first content object, to the potential user or recipient, see column 5, lines 46-51;

evaluating a digital certificate associated with the potential user or recipient, see column 6, lines 49-54;

determining, based on at least the digital certificate that the potential user or recipient has been assigned to the first class, see column 9, line 60 – column 10, line 5;

based on the determination, and at least in part under control of the first rule, making at least some of the secure container contents available to the potential user or recipient, see column 10, lines 1-5.

As per Claim 192.

Benson et al ('281) further discloses the information regarding previous use comprises information regarding the type of rights management information associated with the content items previously used, see column 10, lines 1-5.

As per Claim 193.

Benson et al ('281) further discloses the information regarding previous use comprises information regarding the type of content previously used, see column 10, lines 1-5.

As per Claim 194.

Benson et al ('281) further discloses the information regarding the previous use of content is received from a second remote party, the second remote party having collected the information from the potential user or recipient, see column 14, lines 19-35.

As per Claim 195.

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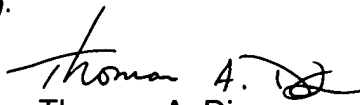
Benson et al ('281) further discloses the steps are performed in the order recited, see figures 4 and 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thomas A. Dixon
Primary Examiner
Art Unit 3629

January 05